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Dated: 8/4/05

Signature: [Signature]

(Susan Lanney)

Docket No.: COTH-P01-002  
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Chan *et al.*

Confirmation No.: 7993

Application No.: 10/676873

Art Unit: 1631

Filed: September 30, 2003

Examiner: E. S. DeJong

For: METHODS OF ENGINEERING SPATIALLY  
CONSERVED MOTIFS IN POLYPEPTIDES

**RESPONSE TO RESTRICTION REQUIREMENT**

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**INTRODUCTORY COMMENTS**

This response is filed in reply to the outstanding Restriction Requirement, mailed May 4, 2005, in connection with the above application. The period for response has been extended to August 4, 2005, by the accompanying petition for two-month extension. Applicants hereby elect Group I, Claims 1-56, *with traverse*, on the following grounds.

Applicants traverse this restriction requirement on the basis that Groups I and II are so closely related and they share common features that would facilitate searching both groups at once. In particular, Claims 60-62 depend on Group I Claim 56, searching the subject matter of Claim 56 necessarily entails searching that of Claims 60-62. Therefore, a search and examination of all pending claims can be made without imposing additional serious burden on the Examiner. Accordingly, reconsideration and withdrawal of the Restriction Requirement are respectfully requested.

Regarding the first species election, Applicants elect *with traverse*, and *for search purpose only*, species (A), a recipient that is a polypeptide. Applicants further elect *with*

*traverse*, and *for search purpose only*, sub-species (C), a recipient polypeptide that binds an extracellular signaling molecule.

Presently, Claims 1-35 and 56 read on the elected species. Among them, Claims 1-16 and 21-35 read on the elected sub-species.

Applicants make these species / sub-species election with *traverse*, because the subject matter of the listed species or sub-species under Group I are closely related. For example, polypeptide (species (A)) and polypeptide complex (species (B)) are closely related. Furthermore, “a recipient polypeptide that binds an extracellular signaling molecule” (sub-species (C)) and “a recipient polypeptide that catalytically modifies a target” (sub-species (D)) are so closely related that they overlap in scope. Therefore, it would not constitute a significant additional burden to examine claims directed to all species or sub-species simultaneously.

As the Examiner correctly points out, at least Claim 56 is generic and encompasses all elected and non-elected species, and at least Claims 21, 22, 25-35 are generic and encompasses all elected and non-elected sub-species. Restrictions imposed on species / sub-species encompassed by generic claims must be withdrawn upon indication of an allowable generic claim (MPEP 809).

Regarding the second species election, Applicants elect *with traverse*, and *for search purpose only*, species (H), a method that includes the presence of a beta-carbon on a glycine residue of the recipient polypeptide.

Presently, Claims 1-56 read on the elected species.

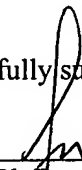
Applicants make this species election with *traverse*, because the subject matter of the listed species under Group I are closely related, and therefore it would not constitute a significant additional burden to examine claims directed to all species simultaneously.

**CONCLUSION**

In view of the above amendment, applicant believes the pending application is in condition for allowance. Applicant believes no other fee is due with this response. However, if any additional fee is due in connection with the filing of this response, please charge our Deposit Account No. **18-1945**, under Order No. **COTH-P01-002** from which the undersigned is authorized to draw.

Dated: August 4, 2005

Respectfully submitted,

By  \_\_\_\_\_  
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